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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Application No.

09/578 194

Applicant(s)

DORNELAS ET AL

Office Action Summary

Examiner

Mary Schmidt

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

Extensions of time may be available for compliance with the shortened period for reply if the communication is received by the Office on or before the expiration of the SIX (6) MONTHS in the mailing date of this communication.

If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

If no period for reply is specified above, the maximum statutory period will apply and will be SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply may, by statute, cause the application to be deemed ABANDONED (35 U.S.C. 133).

Any reply filed by the Office (are that there is a late premium) and the Office communication (even if the late premium is paid) will be considered a late premium adjustment. See 35 U.S.C. 133.

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL** 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-24 is/are pending in the application
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed
- 6) ☐ Claim(s) _____ is/are rejected
- 7) ☐ Claim(s) _____ is/are objected to
- 8) ☐ Claims 1-24 are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved
- 12) ☐ The oath or declaration is objected to by the Examiner

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)
- a) ☐ All b) ☐ Some * c) ☐ None of
- 1 ☐ Certified copies of the priority documents have been received
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))
- * See the attached detailed Office action for a list of the certified copies not received
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 17) ☐ Information Disclosure Statement(s) (PTO 1449, Paper No. s _____)
- 18) ☐ Interview Summary (PTO-413, Paper No. s _____)
- 19) ☐ Notice of Informal Patent Application (PTO 152)
- 20) ☐ Other _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 6-16 and 22-24, drawn to processes for the production of a transgenic plant, transgenic plants and seeds from said plants having the sense orientation of one ASK-gene of group II, classifiable in class 435, subclasses 468 and 419.
 - II. Claims 1-24, drawn to processes for the production of a transgenic plant, transgenic plants and seeds from said plants having the antisense orientation of one ASK-gene of group II and antisense constructs of said gene, classifiable in classes 435 and 536, subclasses (486 and 419) and 24.5, respectively.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. They are drawn to methods of production of a transgenic plant using two different genetic constructs: antisense and sense of the ASK-gene of group II. Expression of sense or antisense function differently since the sense expression of a gene is translated into a protein for

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expression and the antisense expression of a gene acts to inhibit expression of a the gene.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and because they are recognized in the art as divergent subject matter, restriction for examination purposes as indicated is proper.

2. This application contains claims directed to the following patentably distinct species of the claimed invention: (1) different species of genes and (2) different species of plants.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic since no one claim is limited to a single species of ASK-genes of group II or a single plant species.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

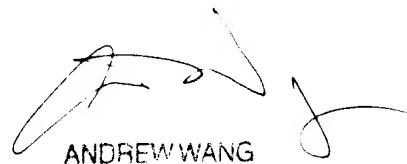
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary M. Schmidt whose telephone number is (703) 308-4471. The examiner can normally be reached on Monday-Friday 9:00 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-5264 for regular communications and (703) 746-5264 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3413.

August 10, 2001



ANDREW WANG
PRIMARY EXAMINER